



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,198	04/19/2001	Nobuyoshi Nakajima	2091-0239P-SP	1185

2292 7590 05/16/2006

BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER

HENDERSON, ADAM

ART UNIT PAPER NUMBER

2622

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/837,198

Applicant(s)

NAKAJIMA ET AL.

Examiner

Adam L. Henderson

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments, see pages 12-14, filed 27 February 2006, with respect to the rejection(s) of claim(s) 1-4, 7-10, and 13-16 under 35 U.S.C. 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Anderson et al. (6,999,637) and Matsumoto et al. (US Patent 6,229,566).

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4, 7-10, 13-16, and 19-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Anderson et al. (US Patent 6,999,637).

4. With regard to claim 1 Anderson et al. disclose a method of generating an album comprising a composite image in which a plurality of images obtained by a digital camera (column 4 lines 48-50) are arranged in a desired layout (column 4 line 64 – column 5 line 3), the digital camera comprising image recording means for recording image data sets representing the

images in a recording medium with accompanying information regarding the image data sets added thereto (column 4 lines 54-59), the album generation method comprising the steps of:

reading the image data sets and the accompanying information added thereto from the recording medium (column 4 lines 48-50) [the system receives the images from the camera, since the camera is transmitting multiple images at once there must inherently be some memory within the camera to hold the plurality of images at least through the transfer period]; and

generating composite image data representing the composite image based on the accompanying information by inserting the respective images represented by the image data sets in image insertion areas of a template having the image insertion areas corresponding to the accompanying information (column 4 line 54 – column 5 line 22) [the system creates a composite image by placing the images on the pages of the album, further the additional information provided by the user may instruct the system to change to template from a default (Anderson et al. gave an example of a 4-up page as the default) to an alternative template (Anderson et al.'s example of a 1-up page) since the additional information provides this information on an image by image basis, then the images will be placed in the openings on the pages according to the additional information to ensure the proper images appear on the proper template types].

5. With regard to claim 2 Anderson et al. disclose an album generation method as defined in claim 1, wherein the template is selected based on the accompanying information (column 4 line 54 – column 5 line 22) [Anderson et al. give the example of the additional information indicating the switch from a 4-up page to a 1-up page based on the specific additional information for an image].

6. With regard to claims 3 and 4 Anderson et al. disclose an album generation method as defined in claims 1 and 2 respectively, wherein the step of generating the composite image data is the step of generating the composite image data by inserting the accompanying information in the template, in addition to the images (column 5 line 19 – column 6 line 40 and column 9 lines 19-36) [Anderson et al. disclose the additional information including data such as voice annotations, category information, and caption data that is included on the album pages (templates) via various disclosed means].

7. With regard to claim 19 Anderson et al. disclose an album generation method as defined in claim 1, wherein the accompanying information includes information indicating whether or not each of the image data sets is used for an album (column 5 lines 15-22) [Anderson et al. disclose that more images may be received than will be used, the additional information then provides the necessary information to determine if the images are to be used in album creation or not].

8. With regard to claim 22 Anderson et al. disclose an album generation method as defined in claim 1, wherein the template is read out from template storage means for storing a plurality of templates, with reference to the information specifying the template, which is recorded on the recording medium (column 9 line 56 – column 10 line 4) [Anderson et al. disclose redesigned layouts/templates for use, as described previously the user selects the desired template and that data is stored in the additional information, in order for the template to be usable there must inherently be some template storage means from which the used templates are read from].

9. Claims 7-10, 13-16, 20, 21, 23, and 24 recite the same essential limitations as claims 1-4, 19, and 22 and are therefore rejected the same analysis.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 5, 6, 11, 12, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. (US Patent 6,999,637) in view of Matsumoto et al. (US Patent 6,229,566).

12. With regard to claim 5 Anderson et al. disclose an album generation method as defined in any one of claims 1 to 4, the digital camera further comprising:

photographing means (digital imaging device, column 4 lines 48-50) for obtaining image data representing a subject by photographing the subject.

Anderson et al. fail to give any further details as to the operation of the digital camera.

Matsumoto et al. disclose a digital camera (FIG. 3) further comprising:

photographing means (image capturing unit 101, FIG. 1) for obtaining image data representing a subject by photographing the subject;

storage means (storage unit 104 and storage unit 109, FIG. 1) for storing recommended composition data sets representing images of recommended composition at various photographing locations by relating photographing information including location information representing the photographing locations to the recommended composition data sets (column 9 line 57 – column 10 line 58) [while FIG. shows the image capturing unit and image

storage/display unit as separate units, column 8 lines 43-47 disclose they may be an integral unit; further disclosed is that the picture images are classified into albums based in photographing information, FIG. 5 shows several of the albums such as a “Europe trip” and “wedding” thus showing the images may be classified according to location information; further column 13 line 32 – column 14 line 6 expressly disclose the automatic saving a “shooting place” (location information) as part of the attribute data and using that data to create albums];

photographing information obtaining means for obtaining acquired photographing information (clock 107, FIG. 1 and shooting place input part, column 13 lines 42-46);

reading means (display controller 112, FIG. 1) for reading a desired one of the recommended composition data sets related to the photographing information corresponding to the acquired photographing information from the storage means, based on the acquired photographing information obtained by the photographing information obtaining means (column 9 line 56 – column 10 line 42) [when the user selects the desired album from FIG. 5 the album is displayed on the screen, thus the display controlling is reading the data from the memory and causing it to be displayed on the display]; and

display means (display 113, FIG. 1) for displaying a recommended composition image represented by the desired recommended composition data set in superposition on an image represented by the image data obtained by the photographing means (FIG. 9) [the display means displays the recommended image data as shown), wherein the image recording means is means for including the acquired photographing information in the accompanying information, for adding the accompanying information to the image data obtained by the photographing means based on the recommended composition, and for recording a plurality of sets of the image data

having the accompanying information in the recording medium [the system allows for addition of accompanying information, for instance, the ability to comments (column 10 lines 33-42), and records all the information in the recording medium].

It would have been obvious at the time of the invention to one of ordinary skill in the art to modify the method of Anderson et al. to include the camera of Matsumoto et al. in order to have a camera where the user could set the desired parameters for the album creation within the camera before transferring the images to the server for the final creation of the album. This would reduce the work required by the user by not requiring them to edit the album details via a computer, they could do it directly on the camera of Matsumoto et al.

13. With regard to claim 6 Anderson et al. disclose an album generation method as defined in claim 5, further comprising the step of replacing the image data obtained according to the desired recommended composition data set with prepared image data corresponding to the desired recommended composition data set (column 6 lines 15-40) [Anderson et al. disclose saving the final album information in some form of electronic media, thus replacing the original image data with the prepared image data].

14. Claims 11, 12, 17, and 18 recite the same essential limitations as claims 5 and 6 and are therefore rejected under the same analysis.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam L. Henderson whose telephone number is 571-272-8619. The examiner can normally be reached on Monday-Friday, 7am to 3:30pm.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ngoc-Yen Vu can be reached on 571-272-7320. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ALH  
9 May 2006



NGOC-YEN VU  
SUPERVISORY PATENT EXAMINER